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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK EGAN

Appeal 2008-3807
Application 09/633,937
Technology Center 3600

Decided:¹ February 23, 2009

Before LINDA E. HORNER, JOHN C. KERINS and,
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Patrick Egan (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 24-56. Appellant cancelled claims 1-23. App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

The Appellant's claimed invention is a prefabricated wall panel. Spec. 1:1-3. Claim 24, reproduced below, is representative of the subject matter on appeal.

24. A pre-fabricated wall panel usable with a door or window jamb with trim yet without jamb furring, comprising:

a first, exterior facing sheet of generally rigid material and having a first thickness and a first sheet perimeter;

a second, interior facing sheet of generally rigid material and having a second thickness and a second sheet perimeter, said second sheet being generally parallel to said first sheet and spaced therefrom a strut thickness;

at least two framing struts being located between said first sheet and said second sheet and having said strut thickness to define a panel volume between said first sheet, said second sheet, and said framing struts;

a polymeric in-situ foam core located in and substantially filling said panel volume;

said framing struts acting as at least part of a dam to help contain said in-situ foam within said panel volume;

an overall panel thickness including the sum of said first thickness, said second thickness and said strut thickness, said overall panel thickness being between approximately $3 \frac{3}{4}$ inches and $4 \frac{1}{4}$ inches;

a jamb member adjacent at least one of said struts, said jamb having a jamb thickness;

a sheet of drywall having a drywall thickness and adjacent said interior facing sheet, said drywall having an interior surface;

a trim piece; and,

wherein said jamb thickness is substantially equal to the sum of said overall panel thickness and said drywall thickness, such that said jamb is substantially flush therewith for said trim piece to be mounted flush across the jamb and drywall without the use of furring.

THE REJECTIONS

The Examiner relies upon the following evidence:

Balla-Goddard	US 5,743,056	Apr. 28, 1998
Porter	US 5,771,645	Jun. 30, 1998

The Appellant seeks our review of the following rejections:

1. The Examiner rejected claims 24-53 under 35 U.S.C. § 103(a) as unpatentable over Balla-Goddard.
2. The Examiner rejected claims 54-56 under 35 U.S.C. § 103(a) as unpatentable over Balla-Goddard and Porter.

ISSUES

The Examiner found it would have been an obvious design choice based on desired use to modify the thickness of the panel of Balla-Goddard to meet the range of thickness required by the claim. Ans. 4. Appellant contends there was no reason to modify Balla-Goddard to result in a panel having the claimed thickness range. App. Br. 8.

The issue before us is:

Has Appellant shown that the Examiner erred in determining that a person of ordinary skill in the art would have been led to modify the panel of Balla-Goddard to result in the claimed panel thickness range based on obvious design choice?

PRINCIPLES OF LAW

A claimed modification to the prior art may be obvious if the claimed structure performs the same function as in the prior art and it presents no novel or unexpected result over the prior art. *See In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975) (use of claimed feature solves no stated problem and presents no unexpected result and “would be an obvious matter of design choice within the skill of the art”). However, when the claimed structure performs differently from the prior art, a finding of obvious design choice is precluded. *In re Gal*, 980 F.2d 717, 719 (Fed. Cir. 1992) (finding of obvious

design choice precluded when claimed structure and the function it performs are different from the prior art).

ANALYSIS

Rejection of claims 24-53 under 35 U.S.C. § 103(a) as unpatentable over Balla-Goddard

Independent claims 24, 44, and 53 recite a prefabricated building component or wall panel comprising two sheets of rigid material sandwiched in parallel around a polymeric in-situ foam core and framing struts. This much is known in the prior art. Spec 1:10-13.

The Examiner found that Balla-Goddard discloses all the elements of the claimed wall panel except for the overall panel thickness being between $3 \frac{3}{4}$ to $4 \frac{1}{4}$ inches, and determined that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to choose the desirable thickness of the panel...to accommodate the opening thickness is considered as an obvious design choice based on desired use.” Ans. 4 (emphasis added). The Examiner further explained that “the claim would have been obvious because a person of ordinary skill has a good reason to pursue the known options within his or her technical grasp.” Ans. 6.

At first glance, Appellant’s claimed panel seems to have been an obvious design choice as simply a minor modification to a conventional wall panel thickness; however, on closer review, it is clear that Appellant’s claimed panel functions differently from the prior art panel and that one having ordinary skill in the art, based on the teachings of Balla-Goddard, would not have been led to modify the overall panel thickness in the manner claimed based simply on design choice.

According to Appellant, prior art panels were built with struts of standard 2 inch by 4 inch nominal lumber (with actual dimensions of 1 ½ inches by 3 ½ inches), giving the panel an overall thickness of approximately 4 ½ inches, while the claimed panel has an overall thickness of 3 ¾ to 4 ¼ inches (preferably 4 ⅞ inches). Spec 1:10-16. When the claimed panel is combined with a ½ inch thick piece of drywall, the overall thickness of the panel becomes 4 ⅞ inches. Spec. 6:18-22. Because many standard window and door jambs are also 4 ⅞ inches thick, this permits these windows and doors to be mounted flush with the wall panel so that trim is conveniently and cost effectively mounted across the jamb without the need for furring strips. Spec 6:9 – 7:14; Figures 6, 7; App. Br. 6-7.

Appellant does not contest that Balla-Goddard discloses the panel of claim 24, except to assert that Balla-Goddard does not disclose the overall panel thickness being 3 ¾ to 4 ¼ inches. App. Br. 5-9. Balla-Goddard discloses a panel with an overall thickness of 86 mm or approximately 3.386 inches. Balla-Goddard, col. 8, ll. 25-28; App. Br. 7. Balla-Goddard, like the other prior art panel mentioned above, does not have an overall panel thickness within the range of 3 ¾ to 4 ¼ inches. Also like the other prior art mentioned above, Balla-Goddard's panel does not function like the claimed panel because Balla-Goddard's overall panel thickness does not permit trim to be conveniently and cost effectively mounted across the window and door jambs without the need for furring strips.

Because Appellant's claimed structure performs differently from the prior art, a finding of obvious design choice is precluded. The Examiner's proffered reasons to modify the panel of Balla-Goddard are insufficient. "[O]bvious design choice based on desired use" (Ans. 4) does not specify an

intended use, and is precluded as a reason to modify because the claimed structure performs differently from the prior art. Similarly, the pursuit of “known options within his or her technical grasp” (Ans. 6) does not in any way point to the particular thickness chosen by Appellant. We acknowledge that “[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp.” *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, ___, 127 S. Ct. 1727, 1742 (2007). The Examiner’s rejection, however, fails to establish a design need or market pressure known in the industry at the time of the invention, and the rejection is not based on a combination of old elements, in which it may have been obvious to try a particular combination from among a finite number of identified, predictable solutions, as was the case before the Court in *KSR*. As such, neither of the Examiner’s explanations provides an adequate reason to modify the panel of Balla-Goddard in the manner claimed.

Appellant contends the “conclusory assertion of ‘design choice’ is not a reason why a person of ordinary skill in the art would have been motivated to modify Balla-Goddard to include the claimed overall panel thickness.” App. Br. 8. Based on a preponderance of the evidence before us, we agree with Appellant. Given this, we cannot sustain the Examiner’s rejection of independent claims 24, 44, and 53, or their dependent claims 25-43 and 45-52.

Rejection of claims 54-56 under 35 U.S.C. § 103(a) as unpatentable over Balla-Goddard and Porter

Claims 54-56 each contain the requirement that the panel be between 3 $\frac{3}{4}$ and 4 $\frac{1}{4}$ inches, and each claim adds the limitation that the panel include an electrical box. The Examiner found that it would have been obvious to a person of ordinary skill in the art to combine Balla-Goddard with the electrical box of Porter. Ans. 5. The rejection provides no further reason to modify the panel of Balla-Goddard to meet the thickness required by the claim. Here, as with the analysis of claim 24, *supra*, we cannot sustain the Examiner's rejection because the Examiner has not provided an adequate reason to modify the panel of Balla-Goddard.

CONCLUSION

Appellant has shown the Examiner erred in determining that a person of ordinary skill in the art would have had a reason to modify the panel of Balla-Goddard to meet the thickness limitation of the claims.

DECISION

We reverse the Examiner's decision to reject claims 24-56.

REVERSED

vsh

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